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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/942,382
Filing Date: August 29, 2001
Appellant(s): JANNE, UUSILEHTO



Geza C. Ziegler
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/27/2007 appealing from the Office action mailed 6/16/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US Patent No. 6,115,601 Ferreira 9-2000

US Patent No. 6,442,532 Kawan 8-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferreira (US Patent No. 6,115,601) in view of Kawan (US Patent No. 6,442,532).

**Re claim 1:** Ferreira discloses:

defining a loading condition for loading money to the money depositing means -see cols. 3-4, in particular col. 4 lines 18-35("A further embodiment of the method is characterized by the method comprising the step of the secure module in response to a trigger from the mobile communication appliance to reload a specified number of communication credits, checking whether the specified number of communication credits falls within a predetermined communication credit range stored in the secure module...an upper limit is stored in the secure module, specifying the maximum number of credits which may be stored in the secure module or may be loaded in one operation. The secure module checks that a request falls within a range defined by the

limit…") and ("It will be appreciated that the credits may directly represent money(so-called electronic money")-see col. 2 lines 32-34 and ("Preferably, the secure module 30 is implemented using smart-card technology")-see col. 5 lines 42-43 and Fig.1;

examining whether the inquiry message transmitted by the money loading means can be received by the money depositing means, ("The reload server 20 also comprises an authenticator 340 for authenticating messages…For authenticating the messages exchanged with the secure module 30…")-see col. 7 lines 16-57, also see col. 3, the method further comprises examining said loading condition ("in response to a trigger, from the mobile communication credits, checking whether the specified number of communication credits falls within a predetermined communication credit range stored in the secure module…)-see col. 4 lines 18-35, wherein if the examination indicates that the loading condition is fulfilled, the loading takes place automatically ("The secure module 30 may be programmed to automatically determine a number or credits to be reloaded. One way of doing this is to always request a predetermined number or credits or alternatively, request to be fully reloaded…")-see col. 8 lines 24-32.

Ferreira discloses wireless communication and a reload server that can receive a reload request message that was sent automatically or triggered by the user, and in return, the reload server can transmit a reload grant message sent to the secure module (smart card) indicating that the reload request has been granted-see col. 5 lines 24-67. Ferreira further discloses a checking program module for checking whether the specified number of communication credits falls within the communication credit range read from the secure module in order to trigger the reload -see col. 8 line 60-col. 9 line 19. Ferreira does not specifically disclose an inquiry message transmitted at intervals by the money loading means. Kawan however, teaches ("Conversely, signals are provided from the transmitter/receiver portion 110 of the terminal 100 to a front end processor via wireless service provider. In this manner, the terminal 100 may be used to wirelessly receive and transmit data to and from a financial institution or financial network.")-see col. 4 lines 50-60, col. 5. It is obvious that the signals taught by Kawan are in fact inquiry messages. The signals transmitted by the terminal disclosed by Kawan are sent to a financial institution or financial network to inquire about transactions taking place that affect the user's accounts i.e., account balances. In addition, it is obvious that the inquiry

signals will be transmitted to the financial institution at intervals due to financial transactions taking place. Further, Ferreira discloses automatic reloading of communication credits (electronic money), and a checking program module stored in program memory which is a task implemented by the computer processor that checks if communication credits falls within the communication credit range in order to trigger a reload. It is obvious that the checking program module would have to run checks of the communication credit balance periodically in order to determine when to reload. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ferreira to include that the wireless terminal transmits signals which include data relating to potential transactions i.e., checking account balances, as was taught by Kawan in order to inquire about account balances before electronic money can be added (reloaded) onto the smart card.

**Re claim 2:** Ferreira discloses: said loading condition used is a minimum sum, wherein in the method, the sum of money deposited in the money depositing means is compared with said minimum sum, and loading takes place, if the deposited sum of money is smaller than said minimum sum. -see (predetermined communication credit range and lower limit) col. 4, lines 19-67;

**Re claim 3:** Ferreira discloses:

wherein said loading condition used is a maximum sum, wherein in the method, the sum of money deposited in the money depositing means is compared with said maximum sum, and loading takes place, if the deposited sum of money is smaller than said maximum sum.-see col. 4 lines 18-67;

**Re claim 4:** Ferreira discloses:

wherein in the method, also the sum of money to be loaded at each loading time is determined ("reload a specified number of communication credits…")-see col. 4 lines 18-67;

**Re claim 5:** Ferreira discloses:

wherein in connection with the loading of money, an identification number is transmitted to the money loading means for identification of the user -see col. 3 line 66-col. 4 line 5, col. 5 line 61-col. 6 line 14, col. 1 lines 23-30.

**Re claim 6:** Ferreira discloses:

wherein a cash card is used as the money depositing means. -see "secure module" col. 1 lines 24-54.

**Re claim 7:** Ferreira does not disclose:

wherein an automatic teller machine is used as the money loading means. Kawan teaches ("the system not only provides the functionality of an ATM network…")-see col. 2 line 34-37, cols. 4-6, Fig. 3A. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ferreira to include loading electronic money onto a smart card using an ATM as taught by Kawan in order to give the user the option to perform many financial services i.e., load electronic money on a smart card, check balances on various accounts, deposit checks, withdraw cash at one location.

**Re claim 8:** Ferreira discloses:

wherein a mobile communication network is used as the money loading means -see col. 5 lines 24-67.

**Re claim 9:** Ferreira discloses:

an electronic device("The mobile communication appliance 10") -see Col. 6 lines 15-col. 7 and Fig. 1 (10);

money depositing means (fig. 1 (30)) comprising means for setting up a data transmission connection to money loading means Fig. 1 (20) and means for loading money from the money loading

means to the money depositing means -see col. 5 lines 24- col. 6 line 14 and Fig. 1.

Further, the remaining limitations are similar to those in claim 1 and are rejected using the same art and rationale;

**Re claim 10:** Ferreira discloses:

wherein the means for loading money comprise wireless communication means ("wireless telecommunication")-see col. 5-col. 6;

**Re claim 11:** Ferreira discloses:

wherein the money depositing means comprise a cash card ("smart card")-see col. 5 lines 42-43;

**Re claim 12:** Ferreira discloses:

the electronic device according to claim 9, further comprising an identification card for identifying the user of the electronic device -see col. 1 lines 24-30, and wherein the money depositing means are arranged in connection with said identification card. -see Fig. 1, and cols. 5-6;

**Re claim 13:** For examination purposes, the Examiner is interpreting claim 13 to mean the electronic device according to claim 9, further comprising means for performing functions of a mobile telephone and as such, Ferreira discloses a mobile communication appliance such as a mobile telephone or PDA (Personal Digital Assistance in col. 5, lines 24-67.

**Re claim 14:** Further, a system would have been necessary to perform previously rejected claims 1 and 9 and is therefore rejected using the same art and rationale.

**(10) Response to Argument**

For the ease of the Board, Examiner presents a mapping of the claim limitations of the Claim 1 to the applicable prior art references.

In response to the appellant's argument that Ferreira and Kawan do not disclose transmitting an inquiry message by the money loading means or examining the inquiry message transmitted by the money loading means. Ferreira discloses examining whether the inquiry message transmitted by the money loading means can be received by the money depositing means ("The reload server 20 also comprises an authenticator for authenticating messages.. For authenticating messages exchanged with the secure module 30 …") in col. 7 lines 16-57. The reload server 20 (computer) taught by Ferreira loads money onto the secure module 30. The reload server 20 exchanges messages with the secure module in order to authenticate the transaction and therefore determine if the secure module is capable of receiving the messages. Furthermore, the appellant's attention is directed to Kawan columns 4 to 5 wherein Kawan teaches signals provided from the transmitter/receiver portion of the terminal so that the

terminal may be used to wirelessly receive and transmit data to and from a financial institution or financial network in order to facilitate a financial transaction.

In response to the appellant's argument that the references fail to show certain features of applicant's invention in particular that claim 1 calls for the loading of money on the money depositing means to be performed automatically in the vicinity of the money loading means and sending an unsolicited "inquiry message" by the terminal which is not initiated by the user. The example of an embodiment given by the appellant calls for the user passing by an ATM that has sent out an inquiry message and which can wirelessly communicate with the smart card (p. 5 paragraph 3 to p. 6 of the Appeal Brief). **It is noted that the features upon which applicant relies (i.e., loading of money on the money depositing means to be performed automatically in the vicinity of the money loading means, when the user passes by an ATM that has sent out an inquiry message and which can wirelessly communicate with the smart card via the mobile terminal…) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The arguments expressed by the**

**appellant are more limiting than the claim language.** [emphasis added].

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ferreira and Kawan are analogous art and teach communication systems in connection with mobile communication appliances, cellular phones, smart card, secure module, reload server and terminal. Ferreira and Kawan disclose systems to perform financial transactions.

In response to the appellant's request to provide an indication as to where any teaching, suggestion or motivation appears in the references, it is noted that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject

matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have had sufficient motivation to combine the individual [elements] forming the claimed [invention]." In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Elda Milef

Conferees:

Vincent Millin

James Kramer

7/5/07

JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

App#: 09/942,382

| Phrase # | Claim 1 | Prior Art (Ferreira 6115601) | Prior Art (Kawan 6,442,532 | | |
|---|---|---|---|---|---|
| 1 | defining a loading condition for loading money to the money depositing means | A further embodiment of the method is characterized by the method comprising the step of the secure module in response to a trigger from the mobile communication appliance to reload a specified number of communication credits, checking whether the specified number of communication credits falls within a predetermined communciation credit range stored in the secure module... -see cols 3-4; col. 4 lines 18-35. credits may directly represent money-col. 2, lines 32-34; the secure module 30 is implemented using smart-card technology-col. 5 lines 42-43; fig. 1 | | | |
| 2 | examining whether the inquiry message transmitted by the money loading means can be received by the money depositing means, the method further comprisies examing said loading condition | The reload server 20 also comprises an authenticator 340 for authenticating messages...For authenticating the messages exchanged with the secure module 30.-see col. 7, lines 16-57, col. 3; in response to a trigger, form the mobile communications appliance... checking whether the specified number of communciation credits falls within a predetermined communciation credit range stored in the secure module...-see col. 4, lines 18-35 | | | |
| 3 | wherein if the examination indicates that the loading condition is fulfilled, the loading takes place automatically | The secure module 30 may be programmed to automatically determine a number or credits to be reloaded. One way of doing this is to always request a predetermined number or credits or alternatively, request to be fully reloaded...")-see col. 8 lines 24-32 | | | |
| 4 | wirelessly transmitting an inquiry message at intervals by the money loading means | | Conversely, signals are provided from the transmitter/receiver portion 110 of the terminal 100 to a front end processor via wireless service provider. In this manner, the terminal 100 may be used to wirelessly receive and transmit data to and from a financial institution or financial network.-see col. 4 lines 50-60, col. 5. | | |
| 5 | | | | | |
| 6 | | | | | |